

REMARKS

Reconsideration of this application and the rejection of claims 1-18 is respectfully requested. Applicant has attempted to address every ground for rejection in the Office Action dated August 12, 2003 (Paper No. 3) and believes this application is now in condition for allowance.

Claims 13-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Bamberger (U.S. Patent No. 2,536,017). Further, claims 1-12 and 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bamberger in view of Welch (U.S. Patent No. 4,317,578). Claims 1 and 13 have been amended to more clearly describe the present invention.

With regard to the rejection of claims 13-16, claim 13 has been amended to recite, among other things, a housing “defining a central throughbore for rotatably receiving at least a portion of the flexible shaft wherein the flexible shaft has a collet nut affixed to a free end, and said attachment formation is configured to circumscribe at least a portion of said collet nut.”

This feature is not taught or even suggested by Bamberger. More specifically, Bamberger does not teach or even suggest an attachment formation configured to circumscribe at least a portion of the collet nut affixed at the free end. In Bamberger, the end cap 14 is elongated and the alleged attachment formation 12 is disposed a distance from and is axially displaced relative to the collet nut 71 such that the attachment configuration does

not circumscribe a portion of the collet nut, as required by amended claim 13. In view of the foregoing, Applicant submits that amended claim 13 overcomes the rejection under 35 U.S.C. §102(b).

With regard to the rejections of claims 1-12 and 17-18 as being unpatentable over Bamberger in view of Welch, the Examiner admits that Bamberger does not disclose the biasing force for biasing the actuator out of engagement with the locking formation. On a fundamental level, Applicant respectfully submits that Bamberger cannot be combined with Welch without significant modification and redesign of Bamberger, especially in the area of the biasing of the finger piece 49 of Bamberger and its engagement with the disc 45. As such, there is no incentive to make the alleged combination. Although Welch appears to have a spring for biasing an actuator out of engagement with the locking formation, claim 1 has been amended to distinguish the present invention from Welch. Specifically, claim 1 has been amended to recite, in part, “a biasing force disposed in a chamber partially defined by the at least one locking formation.”

In contrast to the present invention of amended claim 1, Welch discloses a biasing force disposed in a chamber defined between the actuator 238 and the pin 244, the chamber being remotely located from the locking formation 234. The configuration of the locking actuator and the locking formation of Welch is such that upon depressing the actuator 238 of Welch, the pin 244 overcomes the spring 242 and moves forward to lock into engagement with the slot-like locking formation 234 disposed on the exterior of the chuck

housing. "Pushbutton 238 slides through glide 240 and spring 242 therebetween urges the pushbutton to the retracted position shown in Fig. 12." (Col. 9, lines 23-25). Since the biasing force of Welch is disposed in a chamber defined by the actuator 238 and the pin 244, and not the locking formation, Welch does not disclose or suggest the invention of amended claim 1.

Moreover, the locking formation of Welch does not define a chamber. In fact, the locking formation of Welch is not even located in a chamber, but is located on the exterior of the chuck housing. Amended claim 1, however, requires that the at least one locking formation partially defines the chamber where the biasing force is disposed.

Due to the differences in structure between Welch and amended claim 1, even if Bamberger and Welch could be combined, such a combination fails to disclose or suggest the invention recited in amended claim 1. Further, there is absolutely no incentive in Welch to incorporate the structure of amended claim 1. Thus, it would not be obvious to one of ordinary skill in the art to provide the invention of Bamberger with the amended structure of claim 1 since Welch does not disclose or suggest this structure.

Applicant respectfully suggests that in the outstanding Action, the rejections evidence "picking and choosing" features of various references and combining them when there is no suggestion in those references to do so. It is impermissible within the framework of a 35 U.S.C. § 103 rejection to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full

appreciation of what such reference fairly suggests to one skilled in the art. Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Teachings of references can be combined only if there is some suggestion or incentive to do so. None of these references, whether cited or of record, taken either alone or in combination, disclose or suggest the invention as claimed.

Claims 2-12 depend from claim 1, and claims 14-18 depend from claim 13. These claims are believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional structural elements and novel steps of Applicant's invention.

New claims 19 and 20 are further believed allowable over the references of record. With respect to independent claim 19, both of the cited references fail to disclose or suggest an actuator configured for radial depression of a spring for temporarily locking the locking formation. In Bamberger, the finger piece 49 is configured for axial displacement within a single spring coil 52 which maintains the spring in a radially expanded state, not a radially depressed state. In Welch, the pushbutton actuator 238 is configured for axial compression of the spring 242, not radial depression. Since both Bamberger and Welch fail to disclose or suggest an actuator configured for radial depression of a spring for temporarily locking the locking formation, Applicant requests the allowance of claims 19 and 20.

With respect to new dependent claim 20, Applicant submits that the claim is separately allowable because both Bamberger and Welch fail to disclose or suggest an actuator engaged on the housing approximately midway between the first and second ends. In Bamberger, the finger piece 48 is located towards the rear end of the tool. A movement of the user's hand between the finger piece 48, located rearwardly, and the end cap 14, located at the forward end, is required to change the bit or working attachment. This movement is not required in the operation of the handpiece of claim 20. For the foregoing reasons, Applicant requests the allowance of claim 20.

Applicant submits that in view of the above-identified amendments and remarks, the claims in their present form are patentably distinct over the art of record. Allowance of the rejected claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, she is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,

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